REMARKS

In response to the October 1, 2002 requirement for an election of species, the Applicants had selected doxycycline. In the present Office Action, the Examiner states that since "[n]o prior art with respect to the use of 'doxycycline' to treat cataracts was found,...the search was expanded to the non-elected species of 4-dedimethylamino-tetracycline." (See Office Action, page 2, first paragraph.)

The Examiner states that the claims which recite doxycycline in the methods of the invention are allowable. In particular, Claims 10 and 27 would be allowed "if rewritten in independent form." (See Office Action page 7, paragraph 9.) Claims 10 and 27 have been amended to depend from allowable claims.

Claims 5-9, 15-17, 22-26 and 32-36 are withdrawn from consideration. Accordingly, Claims 1-4, 10-14, 18-21 and 27-31 are pending.

Applicants have responded to the present Office Action in conformity with the discussion the Applicants had with the Examiner during the April 23, 2003 interview.

Objections to the Specification

The Examiner stated that the application does not contain an abstract. (Office Action page 3, paragraph 2.) The Applicants have provided an abstract on a separate page along with this response. Accordingly, this objection is obviated.

Objections to the Claims

The Examiner objected to Claims 15, 16, 17 and 32-34 because "said claims refer to structures which are not in the claims themselves but are provided separately at the end of the application." (Office Action page 3, paragraph 3.)

The Applicants believe that Claims 15, 16, 17 and 32-34 are withdrawn from consideration at this time. (See Office Action page 1, item 4.) Once these claims are being considered, Applicants will amend these claims as suggested by the Examiner.

Rejection under 35 U.S.C. § 112, second paragraph

Claims 15, 16, 32 and 33 have been rejected because of the term "lower alkyl." (Office Action page 4, paragraph 5.)

The Applicants believe that Claims 15, 16, 32 and 33 are withdrawn from consideration at this time. (See Office Action page 1, item 4.) Once these claims are being considered, Applicants will address these rejections.

Rejection under 35 U.S.C. § 103

Claims 1-4, 11-14, 18-21 and 28-31 have been rejected under 35 U.S.C. §103 as being unpatentably obvious over U.S. Patent No. 5,929,055 (Ryan et al.). (Office Action page 5, paragraph 8.)

As discussed with the Examiner during the interview, Applicants assert that the rejection should have more accurately been made under 35 U.S.C. §102(e)/103. That is, when two particular conditions apply, an obviousness rejection should be made under 35 U.S.C. §102(e)/103, as discussed below.

The first condition requires that a prior art reference be published *after* an application for a claimed invention is filed. The present application has an effective filing date of September 28, 1998 which is the date the provisional application was filed. Ryan et al. has a filing date of June 23, 1997, and an issue date of July 27, 1999. Thus, Ryan et al. issued *after* the effective filing date of the present application. Such a time frame qualifies for an obviousness rejection to be made under 35 U.S.C. §102(e)/103.

The second condition requires that the inventive entities of the application and the prior art reference be different. The inventive entity of the present application is Dr. Ryan, Dr. Golub and Dr. Ramamurthy. In addition to these three inventors, the inventive entity of Ryan et al. also includes Dr. McNamara. Accordingly, the inventive entities of the present application and Ryan et al. are different.

Effective November 29, 1999, subject matter which was prior art under 35 U.S.C. §102(e)/103 is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." (See M.P.E.P §706.02 (k)) This revision applies to applications filed on or after November 29, 1999, including continuing applications.

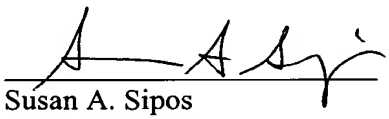
The United States filing date of the present application is March 22, 2001. Thus, once common ownership of Ryan et al. and the present application is established, Ryan et al. is disqualified as prior art against the present application. Applicants have established that the present application and Ryan et al. were commonly owned at the time the present invention was made by the statement found below.

STATEMENT OF COMMON OWNERSHIP

The present application, U.S. Serial No. 09/787,866, and U.S. Patent No. 5,929,055 (Ryan et al.) were, at the time the invention of the present application was made, owned by The Research Foundation of State University of New York, Albany, NY.

Applicants respectfully submit that the application is now in condition for allowance, which action is earnestly solicited. If resolution of any remaining issue is required prior to allowance of this application, it is respectfully requested that the Examiner contact Applicants' undersigned attorney at the telephone number provided below.

Respectfully submitted,



Susan A. Sipos
Registration No.: 43,128
Attorney for Applicant(s)

HOFFMANN & BARON, LLP
6900 Jericho Turnpike
Syosset, New York 11791
(516) 822-3550
SAS/jjc

171475_1

VERSION OF AMENDMENT WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS

Please amend Claims 10 and 27 as follows.

10. (Amended) A method according to Claim 1 ~~Claim 7~~, wherein said tetracycline derivative is doxycycline

27. (Amended) A method according to Claim 18 ~~Claim 24~~, wherein said tetracycline derivative is doxycycline.

IN THE ABSTRACT

Please add the following Abstract on a separate page, after the claims.

ABSTRACT

Methods of reducing the risk of cataract development in a mammal are provided and include administering to the mammal an effective amount of a tetracycline derivative. A preferred tetracycline derivative administered according to the methods of the present invention is 6α-deoxy 5-hydroxy-4-dedimethylaminotetracycline.